

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q76494	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	10/623,621	July 22, 2003	
	First Named Inventor		
	Hyoseop SHIN		
	Art Unit	Examiner	
	2161	LU, CHARLES EDWARD	
<p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons stated on the attached sheets. Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number 39,283</p> <p style="text-align: right;">_____/J. Warren Lytle, Jr./ Signature</p> <p style="text-align: right;">_____ J. Warren Lytle, Jr. Typed or printed name</p> <p style="text-align: right;">_____(202) 293-7060 Telephone number</p> <p style="text-align: right;">_____ February 23, 2009 Date</p>			

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q76494

Hyoscop SHIN

Appln. No.: 10/623,621

Group Art Unit: 2161

Confirmation No.: 5040

Examiner: LU, CHARLES EDWARD

Filed: July 22, 2003

For: INDEX STRUCTURE FOR TV-ANYTIME FORUM METADATA USING XPATH
AND HAVING LOCATION INFORMATION EXPRESSED AS A CODE FOR
DEFINING A KEY (as amended)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated November 21, 2008, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue: Claims 54-89 are all the claims pending in the application, each of which is rejected under 35 U.S.C. §103(a) as being unpatentable over Evain (XP002323574), in view of Kirk et al. (6,823,329). Applicant respectfully traverses the rejection and requests reconsideration taking the following into account.

The present application is directed to the TV-Anytime Forum system. The specification states the following at page 1.

The TV-Anytime Forum is a private standardization organization established in September 1999 with the purpose of developing standards for providing audiovisual related services in a user-friendly environment such as a personal digital recorder (PDR) having a high volume personal storage device. Specifically, the aim of the services is to enable all the users to view and listen to various types of programs (such as conventional broadcasting services, online interactive services and the like) at a desired time and in a desired manner based on the personal storage device.

Claim 54, for example, is directed to an index structure for metadata in which the metadata is divided into fragments. The index structure is for use in locating and extracting a portion of the metadata within a fragment. Evain is relied on as the primary reference. Evain, however, is the TV-Anytime specification for metadata used in the TV-Anytime system that defines the conventional data structures for handling metadata. See page 2 of the specification. The Examiner appropriately recognizes that Evain does not disclose the feature recited in claim 54 concerning the location information in which “at least a part of the location information is expressed as a predetermined code, the predetermined code comprising a predetermined standard code being assigned to said at least a part of the location information according to a convention for associating codes with portions of the metadata.”

Instead of looking to art analogous to the personal digital recorders to which Evain is directed, the Examiner instead cites a secondary reference, Kirk, which concerns a specialized type of database that uses enumerated storage. See col. 1, lines 9-15 and col. 2, lines 20-22 of Kirk. The Examiner asserts that it would have been obvious to modify the TV-Anytime metadata specification (Evain) to use the enumerated storage feature of the specialized database (Kirk) to satisfy the limitation in claim 1 of expressing the location information in the claimed index structure as a predetermined code.

Applicant respectfully submits that a person of ordinary skill in the art would not have looked to Kirk to modify the teachings of Evain because they are drawn to different fields of endeavors and are not analogous art. The Examiner cites *In re Oetiker*¹, for the proposition that to rely upon a prior art reference in rejecting a claim as being obvious, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned. See paragraph 2 of the Final Office Action. It is asserted that "Kirk is reasonably pertinent to the particular problem with which Applicant was concerned. Specifically, the problem is, in a data structure, expressing a value as a (e.g., numeric) code, and using the code instead of the value during processing for efficiency." *Id.*

Applicant respectfully submits that in the Final Office Action only Kirk's solution is compared with Applicant's solution, namely using a code in lieu of a string. The Final Office Action does not address the particular problem with which either Kirk or the Applicant was concerned. When looking at the problems Kirk and the Applicant faced, as the court in *In re Oetiker* instructs, it is clear that they are directed to very different problems.

The problems Applicant solves involve evaluating XPath expressions in XML documents used in personal recording devices. In particular, the application states, at the bottom of page 12, that "an operation to inspect whether fragments are the same by use of the XPath is not a simple one that merely matches simple strings with each other." The application also is directed to solving a problem with abbreviated XPath statements because such statements cause excessive overhead in the "analysis/comparison of the relevant path." *Id.*

¹ *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992)

In contrast, Kirk has nothing to do with solving a problem with evaluating XPath expressions. Rather, Kirk states that it is directed to improving “optimization and execution of queries involving functional expressions against database columns having enumerated storage.” Col. 1, lines 27-29. Kirk also states that the reference describes “an improved method for accelerating execution of database queries including a predicate containing functional expressions against columns having enumerated storage.” Col. 4, lines 29-32. It is respectfully submitted that none of this has anything to do with the problem Applicant set out to solve, namely evaluating XPath expressions in XML documents.

Because the problems Kirk and Applicant attempt to solve are so different, Applicant submits that a person of ordinary skill would not consider the problem Kirk was attempting to solve to be reasonably pertinent to the problem Applicant solved. Accordingly, Kirk is non-analogous prior art and is improperly combined with Evain.

In *In re Oetiker*, the Court of Appeals for the Federal Circuit found that the prior art the Examiner relied upon was not analogous prior art. In that case, both the applicant’s invention and the prior art were fasteners. However, the invention was a fastener for a hose clamp and the prior art cited by the examiner was a fastener for garments. The court found that the garment fastener was not analogous art to the hose clamp fastener. As the court stated: “The combination of elements from non-analogous sources, in a manner that reconstructs the applicant’s invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness.”²

² *In re Oetiker*, 977 F.2d at 1447, 24 USPQ2d at 1446.

If it would not have been obvious to look at fasteners for garments to modify fasteners for hose clamps, it certainly would not have been obvious to look for art dealing with optimizing queries in enumerated storage systems when attempting to solve a problem dealing with evaluating XPath expressions in XML documents. The application and prior art reference in *In re Oetiker* both dealt with fasteners and was much closer related than the Kirk reference and the Applicant's invention, which are directed to two very different types of systems. Just as a hose clamp is very different from a garment clamp, Evain's XML data structure used for TV-Anytime metadata to control a personal digital recorder, is very different from Kirk's specialized database that uses enumerated storage to optimize queries against columns in the database.

Accordingly, a person of ordinary skill in the art, faced with the problems the Applicant faced, would not have looked to Kirk to solve the problems with evaluating XPath expressions.

Therefore, it is submitted that a *prima facie* case of obviousness has not been established, but rather impermissible hindsight gained from Applicant's disclosure has been used to locate the Kirk reference and combine its teachings with Evain.

Respectfully submitted,

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